



IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Appln of: GOEDEKE et al.

Docket: P-8896

Serial No.: 09/731,178

Group Art Unit: 2655

Filed: December 06, 2000

Examiner: OPSASNICK, Michael

For: AUTOMATIC VOICE AND DATA RECOGNITION FOR IMPLANTED MEDICAL DEVICE INSTRUMENT SYSTEMS

APPELLANTS APPEAL BRIEF UNDER 37 C.F.R. § 1.192

Mail Stop Appeal Brief – Patents
Commissioner for Patents
P.O. Box 1450
Washington, D.C. 20231

Sir:

Applicants submit this appeal brief, in support of Applicants' appeal from the rejection of the claims by the Examiner in the Office Action mailed June 23, 2005, in accordance with a Notice of Appeal filed on even date herewith, and which accordingly is due September 23, 2005. The Appeal Brief is submitted in triplicate as required by 37 C.F.R. §1.192 along with the requisite filing fee of \$340.00 set forth in C.F.R. §1.17(c), in accordance with which this Appeal Brief is timely filed.

1. REAL PARTY IN INTEREST

The real party in interest is the assignee of the present patent application, Medtronic, Inc.

2. RELATED APPEALS AND INTERFERENCES

None.

09/27/2005 BABRAHA1 00000082 132546 09731178

01 FC:1402 500.00 DA

3. STATUS OF THE CLAIMS

Claims 1-30 are pending and stand rejected and Applicant appeals the rejections for each of claims 1-30.

4. STATUS OF AMENDMENTS

This application has received six office actions, two of which were made Final and two advisory actions. The present appeal is being filed after a non-final office action mailed on June 23, 2005. Thus, there are no amendments after final for consideration.

5. SUMMARY OF THE INVENTION

The present invention relates to dedicated electronic devices that are used to program the settings of implantable medical devices (IMD) that provide life saving and life sustaining therapies to patients. Such IMDs would include implantable pacemakers and/or defibrillators. Each IMD has numerous settings that are selected for a given patient based upon their specific needs and conditions. A medical device programmer (hereinafter "programmer") is an instrument that wirelessly communicates with an IMD to allow a physician to make or modify these settings.

The programmer communicates with the IMD through telemetry that may include inductive coupling by placing a programming head proximate the implant site (e.g., on the patient's chest) or through RF transmission over longer distances. During routine follow-up visits, the programmer may be used to "interrogate" the IMD and obtain historical medical data sensed or generated by the IMD. At this time, the physician may alter the settings of the IMD.

Another important communication time between the programmer and the IMD is during the surgical implantation procedure. During this time, all normal surgical procedures are following including maintaining a sterile field. Implantation often involves the use of fluoroscopy; thus, requiring the medical personnel to wear heavy lead vests. The result is that the operation of the programmer is another complicating factor in an already medically complex, physically complex and physically constrained environment. There are many people present, they are physically close and they are, of course, speaking to one another.

The present invention provides a medical device programmer having voice recognition capabilities. The medical device programmer interrogates the IMD and determines a status of the IMD; then the medical device programmer selects a subset of available voice commands based upon that interrogation and allows those commands to be executed via voice recognition. Thus, the physician or other person may use voice commands to control or operate the medical device programmer, which in turn executes commands or otherwise controls and/or monitors the IMD.

6. ISSUES

- A. No Prima Facie Case of Obviousness Has Been Provided**
- B. The Patent Laws and Rules of Practice Have Not Been Followed and/or Properly Interpreted During the Examination of the Instant Application and the Present Application Has Not Received Proper Examination**

7. GROUPING OF CLAIMS

The claims stand or fall together.

8. ARGUMENTS**A. No Prima Facie Case of Obviousness Has Been Provided**Basis of Rejection

The pending claims have been rejected under 35 USC 103(a). In particular, the independent claims (1, 19, 20, 26 and 30) have been rejected under this section as being unpatentable over US Patent 5,792,204 ("Snell") in view of US Patent 5,761,641 ("Rozak").

35 USC 103(a) states that a "patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the claimed subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time of the invention to a person having ordinary skill in the art to which said subject matter pertains."

In order to make a determination of obviousness under section 103(a), the Examiner must:

- 1) Determine the scope and contents of the prior art;
- 2) Ascertain the differences between the prior art and the claims in issue;
- 3) Resolve the level of ordinary skill in the pertinent art; and
- 4) Evaluate evidence of secondary considerations.

MPEP 2141

In determining the differences between the prior art and the claims, the question under 35 U.S.C. 103 is not whether the differences themselves would have been obvious, but whether the claimed invention as a whole would have been obvious.

MPEP 2141.02

Distilling an invention down to the "gist" or "thrust" of an invention disregards the requirement of analyzing the subject matter "as a whole."

MPEP 2141.02

The legal concept of *prima facie* obviousness is a procedural tool of examination which applies broadly to all arts. It allocates who has the burden of going forward with production of evidence in each step of the examination process. (Citations omitted) The Examiner bears the initial burden of factually supporting any *prima facie* conclusion of obviousness. If the Examiner does not produce a *prima facie* case, the applicant is under no obligation to submit evidence of nonobviousness. If, however, the examiner does produce a *prima facie* case, the burden of coming forward with evidence or arguments shifts to the applicant who may submit additional evidence of nonobviousness, such as comparative test data showing that the claimed invention possesses improved properties not expected by the prior art.

MPEP 2142

The tendency to resort to "hindsight" based upon applicant's disclosure is often difficult to avoid due to the very nature of the examination process. However, impermissible hindsight must be avoided and the legal conclusion must be reached on the basis of facts gleaned from the prior art.

MPEP 2142**Claim Language**

Claim 1 of the present application includes in relevant part:

A system for interfacing with an implanted medical device, the system comprising . . . a speech recognition circuit . . . and adapted to recognize . . . a subset of commands from a set of commands . . . corresponding to a task to be performed on the implanted medical device . . . a processor arrangement coupled to the speech recognition circuit and in communication with the implanted medical device . . . to receive data indicative of an implanted medial device state from the implanted medical device and automatically select the subset of commands as a function of the device state.

Thus, the programmer (a device distinct from the IMD) communicates with the IMD (a device distinct from the programmer); the programmer determines a state of the IMD and the programmer automatically selects a subset of voice commands based upon the state of the IMD.

Scope and Content of the Prior Art & Differences from Claimed Invention

Snell teaches a medical device programmer that is operable using voice commands with off-the-shelf, commercial voice recognition software.

Snell does not teach or suggest creating subsets of commands. Snell does not teach or suggest interrogating an IMD to determine its state for any reason linked to voice recognition. Snell does not teach or suggest interrogating an IMD and determining its state and selecting a subset of voice commands based upon this determined state.

Rozak teaches a software implementation on a single device that allows a user to define a voice command that inserts predefined text. The voice command may be used in multiple software applications to perform the same insertion on the same, single device. For example, when the operator speaks "command 1" a particular block of text is inserted in a Word document or the same text is inserted into an Excel spreadsheet.

Rozak is non-analogous to medical device and medical device programmers. Rozak fails to teach or suggest having one device communicate with a second device, determine the status of the second device, and select a subset of voice commands useable on the first device based upon the status of the second device. In summary, Rozak fails to provide for any of the noted deficiencies of the Snell reference.

Failure to Establish Prima Facie Case of Obviousness

Even if the references are combined, they fail to teach the claimed invention. As such, no prima facie case of obviousness has been established at any point during prosecution. Therefore the rejection is unsupportable and must be withdrawn.

Discussion of Examiner's Rejection

In the Office Action dated June 23, 2006 the relevant rejection is repeated from previous Office Actions in paragraph 4.

According to the Examiner, Snell teaches the following:

1. a "speech recognizer" matching the input voice command to the subset of commands and converting the recognized voice command into a selection code (control program instructions, col. 4, line 5).

Applicant has repeatedly argued that Snell does not include a "subset of commands" and the Examiner has not responded to the substance of this argument. It is clear that the claim language, e.g., claim 1, includes a specific meaning for a subset of commands it is therefore improper for the Examiner to simply dismiss this claim limitation from consideration.

Snell does not include an interrogation of the IMD and a selection of a subset of commands by the programmer based on that determination. This has been repeatedly asserted to the Examiner and has yet to be properly addressed.

The purported support for the above bullet point from the Examiner is at Col. 4, line 5 of the Snell reference. Notably indicating a lack of understanding of the present claims and the references relied upon, this section addresses the *implantable medical device* and its control circuitry.

To reiterate, Snell does not teach nor suggest that the programmer 32 interrogate the implantable device 30 to determine a state of the implantable device 30 and then select a subset of voice commands from a full set of available voice commands based upon this determination.

As a further truncation or selective consideration of the claim language, another bullet point from the rejection is:

2. displaying the received data generated by the implanted medical device in response to the execution of the command as well as implanted medical device state data (col. 4, lines 63-65 and col. 5, lines 3-13)

The relevant language from, e.g., claim 1, is:

a medical data processing instrument coupled to the processor arrangement and adapted to, in response to the control signal, execute the one of the subset of commands and to display data generated in response to execution of the one of the subset of commands

Thus, the displayed data is indicative of an executed voice command from a subset of commands that is obtained by the programmer based upon an interrogation of the IMD by the programmer. In other words, any medical device programmer by definition communicates with an IMD. Thus, such a programmer will certainly display information and settings, which is what the cited passages reflect. At this point, Snell has simply discussed implantable devices and programmers in a general sense and has yet to introduce voice recognition.

In summary, the Examiner has failed to consider the claims in their entirety and has failed to consider the reference in its entirety.

The Examiner merely states that Snell does not "explicitly teach displaying the selectable subset of commands as a function of the device." This implies that while not displayed, Snell does select a subset of commands as a function of the device which is factually incorrect.

The Examiner now introduces Rozak and states that "it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the teachings of Snell with context specific available commands because it would

advantageously reduce user redundant activity by using context specific commands" and cites col. 1, lines 34-40. This citation includes the following:

The user would typically be required to type such a sentence each time the user inserted it into a document.

Because manually inserting commonly inserted pieces of information involves significant redundant user activity as demonstrated above, it would be preferable to provide a convenient way to provide for efficient reinsertion of a previously entered piece of information.

If the teaching of Snell and Rozak are combined, the result could be a medical device programmer that has multiple software applications and the voice commands will have the same effect in each of those applications.

Neither Snell, Rozak, nor the combination of Snell and Rozak teach or suggest that a medical device programmer interrogates an implantable device, determines the state of that device and based upon that state, selects a subset of voice commands that are available.

The rejection is improper and unsupportable. The remaining independent claims have similar language and are allowable for at least the same reasons presented above. Similarly, the dependent claims are allowable for at least the same reasons discussed above.

B. The Patent Laws and Rules of Practice Have Not Been Followed and/or Properly Interpreted During the Examination of the Instant Application and the Present Application Has Not Received Proper Examination.

During the course of examination, certain claims may be rejected from an application based upon the teachings of the prior art. In order to substantiate a prima

facie case of obviousness, the Examiner must properly construe the claims and identify what each reference teaches and what each reference lacks. Furthermore, the Examiner must provide a legally sufficient motivation to combine those references and establish that when combined, the result teaches each and every properly construed element of the claims in question.

If the Examiner in fact establishes a *prima facie* case of obviousness, the burden shifts to the Applicant and the Applicant has the opportunity to rebut that case based upon various established avenues such as commercial success, unexpected results, etc. This means that while the rejection was initially proper, additional information overcomes this rejection.

In the present case, the Examiner appears to be under that impression that any statement of rejection made, no matter how unsupportable, establishes a *prima facie* case of obviousness and shifts this burden. The Examiner apparently fails to recognize that the Applicant may respond to a rejection by establishing that a *prima facie* case has not been established. This may be done in any of a number of ways, such as establishing that there is no proper motivation to combine references or showing that the combination does not teach the invention as claimed.

In the present case, Applicant has repeatedly asserted that the Examiner has failed to make a *prima facie* case. However, rather than responding to the substance of the arguments, each subsequent Office Action focuses on an ever more divergent and immaterial issue that has resulted in, to say the least, an overly convoluted prosecution for a fairly straightforward technology based on references that are clearly insufficient to form a proper rejection.

While the full prosecution record should be reviewed to fully comprehend the frustration generated, Applicant provides the following summary. While admittedly lengthy, this overview illustrates the vast deficiencies encountered during the examination of the present application.

1. First Office Action

Paper #7

4/10/03

This action was prepared by Examiner Smits and presents a rejection under 35 USC 103 of claims 1-30 over Snell; thus, this constitutes single reference obviousness rejection. Relevant to the independent claims, Examiner Smits lists six (6) bullet points as to how the Examiner has interpreted the Snell reference. Examiner Smits then states that "Snell does not explicitly teach displaying the selectable subset of commands as a function of the device." The Examiner then goes on to take "Official Notice" that it is "old and notoriously well known to have context-sensitive commands, and to display them for user selection by voice (or, of course, by keyboard or mouse) from a displayed menu."

2. Applicant's first response submitted 7/10/03 and resubmitted on 8/18/03

- Applicant argued that the failure to provide a secondary reference for acknowledged deficiencies in the Snell reference failed to establish a *prima facie* case of obviousness.
- Applicant further argued that Snell (contrary to the Examiner assertions) did not teach selecting a subset of commands in a programmer based upon the state of an IMD.
- Applicant expounded upon why the medical device programmer/IMD context was unique and why taking Official Notice of a vast majority of the claimed subject matter amounted to not considering the claims as a whole.

- Similarly, Applicant argued that in light of a proper construction of the claims and a proper analysis of Snell, the “combination” of Snell’s teachings with what Official Notice was taken of failed to teach the claims.

3. Second Office Action (Final) Paper #11 11/3/03

Examiner Smits no longer handles the application and Examiner Opsasnick continues prosecution.

The substance of the rejection is copied verbatim from the first office action.

The Examiner’s “response” to Applicant’s arguments begins at page 5 of the Office Action. Here, the Examiner minimally “paraphrases” Applicant’s arguments regarding what Snell fails to teach into a single sentence. The entirety of the Examiner’s rebuttal constitutes paraphrasing the bullet points/citations from the first office action (which were repeated in this office action).

The Examiner then states that since Applicant has argued no secondary reference was provided, the Examiner will take this as a “challenge” to the Official Notice. The Examiner then “points” to a previously cited reference, but does not change or modify the rejection to include such a reference.

4. Applicant’s After-Final Response 1/13/04

Applicant amended the claim language to more clearly indicate that the programmer was in communication with the IMD and that the programmer automatically selected the subset of commands based upon the determined state of the programmer.

Applicant’s remarks were brief and pointed out how the claims were amended. Furthermore, the remarks indicated how the claims were different than the teachings of

Snell and though the “Brandt” reference was only “pointed” to in the previous office action, if relied upon the combined teachings would not teach the claimed invention.

5. Advisory Action Paper #13 1/21/04

The Amendment was denied entry because it would “raise new issues that would require further search and consideration.”

The Examiner’s comments repeat the same citation to Snell (column and line) and notably, references the Brandt reference which still has not formed the basis of any rejection of record.

6. RCE 2/3/04

Applicant filed an RCE and indicated that the previously denied amendment should be entered.

7. (Third) Non-Final Office Action Paper #15 2/25/04

This is an exact copy of the earlier office action (paper #11 (Item 4 above)). The only difference being that the “Response to Arguments” section ends after citing Snell (as opposed to paper 11 which continues with “Official Notice” and “pointing” to Brandt (which is STILL not cited in a rejection)).

In both papers 11 and 15, the response section begins by stating that the Examiner is responding to the “arguments filed 8/18/03.”

The Examiner was responding to the wrong paper, the wrong set of arguments and the wrong set of claims. All of this, despite the Advisory Action indicating “new issues” and such.

8. Applicants Response

5/24/04

- Applicant re-presented the correct claims (without further amendment)
- Applicant pointed out the Office Action of paper 15 considered the wrong claims and the wrong remarks

9. (Fourth) Final Office Action

Paper 17

8/6/04

Despite having never examined the claims pending from the RCE, this Office Action is made FINAL.

The substance of the rejection is again copied from the very first office action.

In the response to argument section –

- The Examiner again references the remarks filed 8/18/03 (pre RCE, pre amended claims)
- The Examiner again repeats the non-supportive citation to Snell
- The Examiner again languishes over the Official Notice issue and expounds further this time than in Paper 11, where the issue was tangentially relevant
- The Examiner states that Applicant “did not directly challenge the Official Notice”
- Applicant reminds the BAPI that in Paper 11, the Examiner stated that with respect to Applicant’s arguments, the “examiner interprets this as a challenge to the Official Notice taken by the Examiner.”

Thus, the Examiner is not only considering the wrong claim set, the wrong set of issues, and the wrong remarks, the Examiner is engaging in circular arguments with himself.

The Examiner lists, but does not include in any rejection, six (6) references that purportedly support the Official Notice issue.

10. AFTER FINAL RESPONSEOctober 22, 2004

- Applicant again presents the correct claim set
- Applicant again points out that the Examiner is considering the wrong claims, arguments and issues
- Applicant again states how the claims are patentably distinguishable over Snell and any combination based upon Official Notice
- Applicant explains why the Examiner's condensation of the claimed invention into a "gist" or "thrust" is inappropriate and how doing so has resulted in the oft repeated rejection being fundamentally flawed.
- Applicant stated:

The inquiry is not whether speech recognition has ever been utilized to define different lists of recognized words, but rather would one of ordinary skill in the art have been motivated to modify a medical device programmer to include voice recognition capability, define subsets of commands, interrogate an IMD, determine an IMD state and automatically select a subset of commands based on the state of the IMD. No reference or combination of references teaches or suggests the invention as claimed.

11. Advisory Action11/23/04

- Asserts incorrectly that the amended claims were considered
- Asserts that Applicant has not "officially challenged the Official Notice" (See discussion of papers 11 and 17 above as to the absurdity of this)
- Asserts the "newly presented" arguments require further search and consideration

The Examiner apparently believes that Applicant's restatement of the basic requirements of a proper rejection constitutes a newly presented argument requiring

further search. However, Applicant had been operating under the belief that such basic tenets of examination were previously known.

12. RCE Filed12/15/04

This is the second RCE filed by Applicant. The entirety of the prosecution to this point has been a colossal waste of time, money and resources, as the Examiner never addressed the merits of any issue raised, but simply repeated the rejection language drafted by Examiner Smits and proceeded down an obtuse path regarding Official Notice.

In this, the second RCE filed, Applicant:

- Again presented the claims to be examined
- Presented the differences between the invention as claimed and the reference(s) cited
- Revisited the Official Notice issue; pointing out what is really lacking in the reference and how such deficiencies are not provided by taking Official Notice of known voice recognition technology
- To avoid continuing this ridiculous series of tangential issues, Applicant formally and explicitly challenged the Official Notice taken
- Cited controlling CAFC case law to support Applicant's previously-made and now-restated arguments that the Examiner is not permitted to pick and choose elements from disparate sources and combine them without considering the claimed invention as a whole. Because that holding is directly relevant to the present case, and the language quoted became an issue subsequently in prosecution, Applicant re-presents the cited passage here.

In making the assessment of differences, section 103 specifically requires consideration of the claimed invention "as a whole." ***Inventions typically are new combinations of existing principles or features.*** Envtl. Designs, Ltd. v. Union Oil Co., 713 F.2d 693, 698 (Fed. Cir. 1983) (noting that "virtually all [inventions]

are combinations of old elements."). The "as a whole" instruction [**9] in title 35 prevents evaluation of the invention part by part.

Without this important requirement, an obviousness assessment might break an invention into its component parts (A + B + C), then find a prior art reference containing A, another containing B, and another containing C, and on that basis alone declare the invention obvious. This form of hindsight reasoning, using the invention as a roadmap to find its prior art components, would discount the value of combining various existing features or principles in a new way to achieve a new result - often the very definition of invention. Chance v Ruiz, 357 F.3d 1270; 2004 U.S. App. LEXIS 1325; 69 U.S.P.Q.2D (BNA) 1686 (CAFC 2004) (Emphasis Added)

- Reiterated that the claims are directed to medical device programmers for implantable medical devices having unique characteristics
- Explained in detail why modifying Snell as suggested by the Examiner still does not lead to the claimed invention
- Restated again what the basic requirements would be to present a proper rejection of the claims at issue.

13. (Fifth) Office Action

1/19/05

- Modified action slightly so that rejection of independent claims under section 103 is over Snell in view of Rozak
- Bullet points regarding Snell remain unchanged from Examiner Smits' initial drafting
- Rozak simply replaces what Examiner stated was taught by taking Official Notice
- The Examiner's Response to Arguments is most notable –

States that CAFC in above cited case was merely "restating the issues of old regarding 103, i.e., ***that the value of combining various existing features or principles in a new way lies in the achievement of unexpected results.*** MPEP 716.02(a). (Emphasis added)

The Examiner has clearly misunderstood the distinctions expounded upon by the CAFC that virtually all inventions are combinations of elements that, in and of themselves, and in isolation, are known at some level, by definition. Furthermore, merely finding references illustrating each element absent a consideration of the claim as a whole does not form a proper basis of a rejection. It does not, however, now mean that evidence of secondary considerations is mandated by the CAFC to establish a patentable invention.

The Examiner further states that "hindsight reasoning is overcome when the motivation to combine two or more references is found." (Emphasis added)

Thus, the Examiner has created two novel principles of patent law.

- 1) Secondary considerations are now mandatory to define a patentable invention; and
- 2) Hindsight reasoning, heretofore entirely impermissible, is proper if later supported.

Applicant respectfully disagrees.

14. Response to Office Action

3/21/05

- Applicant explains why the combination of Snell and Rozak fails to teach the present claims
- Applicant explains that the Examiner has still failed to provide a teaching or suggestion to utilize a medical device programmer to interrogate an IMD, determine the IMDs settings and based upon that action, select a subset of voice commands
- Applicant restated that the CAFC case cited was not limited or directed to unexpected results and secondary considerations
- Applicant stated that hindsight reasoning is never a permissible basis for a rejection and is not something to later be overcome
- Applicant stated that (much like the long road of Official Notice) the discussion of unexpected results was irrelevant to the present case as

Applicant has not and is not offering evidence of secondary considerations and specifically unexpected results.

- Because the Examiner later states he is “not clear” with respect to Applicant’s position, certain statements from this response are quoted:

“The Examiner’s discussion of ‘unexpected results’ is irrelevant.”

“Applicant has not asserted nor argued ‘unexpected results.’”

“The issue of unexpected results is currently irrelevant in the instant application.”

15. (Sixth) Office Action

6/23/05

After five (5) office actions and two (2) advisory actions, the Examiner states that “the title of the invention is not descriptive. A new title is required that is clearly indicative of the invention to which the claims are directed.”

No further explanation is provided.

The title is: Automatic Voice and Data Recognition for Implanted Medical Device Instrument System.

Applicant respectfully asserts the title is appropriate.

The Examiner copies the text of the rejection from the previous office action where Snell is combined with Rozak.

The Examiner’s Response to Arguments section is again remarkable.

While having failed to address the substantive issues regarding what is claimed and what is not taught by the references and simply repeating a reference to an unsupportive passage within the Snell reference, first drafted by a different Examiner eight actions past, the Examiner asserts that Applicant’s remarks are improper because they amount to a “general allegation” that the claims define patentable subject matter.

Now, not only is the Examiner selectively considering elements of the claims in isolation and incorrectly, but is subdividing Applicant's response into sections and dismissing sections based upon conclusory notions.

The Examiner states that "Applicant makes a general sweeping statement that neither Snell or Rozak, alone or in combination, teach the referred to claim language." It is Applicant's repeatedly-stated position that the references fail to teach a medical device programmer that interrogate a device, determines the status of the device, and selects a subset of voice prompts from a set of voice prompts based upon this determined status. Applicant is at a loss as to how they could be more concise, focused, and repetitive. The Examiner's rebuttal is to state that Snell interfaces with an implantable medical device. Yes it does; all medical device programmers do. However, there is still no teaching in Snell, in Rozak, in the dubious statement of Official Notice, or the other references cited that addresses what Applicant has claimed and what Applicant has argued.

In the second paragraph of section 8, the Examiner asserts that "applicant is basing the hindsight reasoning argument on unexpected results." To clarify that which should be abundantly clear; the Examiner may not use impermissible hindsight reasoning to forge a rejection. Secondary considerations and unexpected results are not at issue in the present case.

One may reasonably wonder, with such basic tenets of patent practice at issue and Applicant's statements being rather unambiguous, how the Examiner may have concluded that it was in fact the Applicant who has argued that "unexpected results" are either necessary or are being articulated in the present case. The answer, according to the Examiner, is that Applicant quoted the CAFC holding above.

The Examiner states that:

"discounting the value of combining various existing features or principles in a new way to achieve a new result – often the very definition of invention" → achieving a 'new result' **is equivalent to saying 'an unexpected result'**. Applicant's further argue that the examiner's discussion of "unexpected results" is irrelevant; examiner notes that the applicant's representative himself raised the issue of unexpected results on page 14 of the fax submitted on 12/15/04. [the CAFC quotation] ***It is now not clear as to the position of the applicant with respect to unexpected results. (Emphasis added)***

From Applicant's response of 3/21/05:

"The Examiner's discussion of 'unexpected results' is irrelevant."
"Applicant has not asserted nor argued 'unexpected results.'"
"The issue of unexpected results is currently irrelevant in the instant application."

First, for an Examiner with apparent signatory authority to state that "unexpected results" are the *equivalent* of a new result defining an invention, as articulated (in context) by the CAFC, is troubling.

Second, for the Examiner to so misconstrue a quoted citation, then rely upon that misconstrued construction to introduce an irrelevant concept, is troubling.

Third, for the Examiner to assert that it was the Applicant who introduced yet another diversion because of this mangled interpretation of the CAFC's holding is troubling.

Finally, for the Examiner to indicate confusion as to Applicant's position--

From Applicant's response of 3/21/05:

"The Examiner's discussion of 'unexpected results' is irrelevant."
"Applicant has not asserted nor argued 'unexpected results.'"
"The issue of unexpected results is currently irrelevant in the instant application."

--with respect to this issue, based upon labeling a "new result" broadly defining invention conceptually as a whole by the CAFC as "equivalent" to the very specific notion of secondary considerations and "unexpected results" is troubling.

CONCLUSION

Applicant respectfully asserts that the present claims are allowable over the art of record and requests favorable action. Specifically, none of the references alone or in combination teach a programmer with voice recognition capabilities that interrogates an IMD, determines a state of that IMD, and then, based upon that determined state, selects a subset of voice commands.

There have been eight "substantive actions" (including advisory actions), none of which have addressed in any substance the merits of the claims and Applicant's arguments. Entire RCE lifetimes have been squandered and fees wasted without even examining the correct claims. Applicant respectfully asserts that this prosecution history is unduly tortuous and requests relief from the BPAI.

The Commissioner is hereby authorized to charge any additional fees associated with filing of this Appeal Brief to our Deposit Account No. 13-2546.

GOEDEKE et al.,

Date: _____

Daniel G. Chapik

Reg. No. 43,424

(763) 514-3066

No. 27,581

APPENDIX

Claims 1-30 of the present application read as follows:

1. (Previously presented) A system for interfacing with an implanted medical device, the system comprising:

a microphone;

a speech recognition circuit coupled to the microphone and adapted to recognize an audio signal from the microphone, the audio signal corresponding to one of a subset of commands from a set of commands and each command corresponding to a task to be performed on the implanted medical device, the speech recognition circuit further adapted to convert the audio signal into a selection code and match the selection code to one of the subset of commands;

a display device;

a processor arrangement coupled to the speech recognition circuit, to the display device, and in communication with the implanted medical device, the processor arrangement configured to receive data indicative of an implanted medical device state from the implanted medical device and automatically select the subset of commands as a function of the device state, the processor arrangement configured to display the device state data and the subset of commands, and generate a control signal in response to the selection code match; and a medical data processing instrument coupled to the processor arrangement and adapted to, in response to the control signal, execute the one of the subset of commands and to display data generated in response to execution of the one of the subset of commands.

2. (Original) The system of claim 1, further including a bandpass amplifier circuit coupled to the microphone and adapted to reject ambient background noise signals that are not speech generated.

3. (Original) The system of claim 1, further including a noise suppression circuit coupled

to the microphone and adapted to produce a noise-suppressed speech signal in response to noise suppression information received from the microphone.

4. (Original) The system of claim 1, wherein the speech recognition circuit further includes a memory arrangement configured to store the set of commands and the device state data and adapted to be accessed by the processor upon recognition of the audio signal received from the microphone.
5. (Original) The system of claim 4, wherein the memory arrangement is adapted to store the subset of commands corresponding to at least one of a plurality of implanted device states.
6. (Original) The system of claim 4, wherein the speech recognition circuit further includes a control signal circuit adapted to generate control signals for the medical data processing instrument in response to the selection code match.
7. (Original) The system of claim 1, wherein the medical data processing instrument includes a pacing system analyzer.
8. (Original) The system of claim 1, wherein the medical data processing instrument includes an implanted medical device programming unit adapted to interrogate and program the implanted device.
9. (Original) The system of claim 1, wherein the display includes a display screen adapted for use by a user of the medical data processing instrument and coupled to the speech recognition circuit and the processor arrangement.
10. (Original) The system of claim 9, wherein the microphone is a unidirectional microphone mounted on the display screen and coupled to the medical data processing

instrument, thereby reducing background noise.

11. (Original) The system of claim 1, wherein the microphone is a unidirectional microphone arrangement adapted to be donned and steered by a user of the medical data processing instrument, thereby reducing background noise.
12. (Original) The system of claim 10, wherein the microphone is adapted to be directionally steered by a user of the medical data processing instrument for improved audio signal clarity.
13. (Original) The system of claim 4, wherein the speech recognition circuit and the processor are adapted to interact with a user to generate the set of commands to be stored in the memory arrangement.
14. (Original) The system of claim 13, wherein the processor is adapted to receive and validate the user via a user selection code, the user selection code providing access to differing levels of commands for controlling the data processing instrument.
15. (Original) The system of claim 1, further comprising an audio circuit coupled to the speech recognition circuit configured and arranged to produce an audio signal confirming receipt of a voice selected command from the subset of commands.
16. (Original) The system of claim 15, wherein the audio circuit is configured and arranged to produce an audio signal representing the device state with the subset of commands.
17. (Original) The system of claim 1, further comprising an audio circuit coupled to the speech recognition circuit configured and arranged to reproduce and repeat a voice selected

command and to produce an audio signal confirming execution of the voice selected command.

18. (Original) The system of claim 1, wherein the speech recognition circuit is coupled to the medical data processing instrument via a communications network.

19. (Previously presented) A system for interfacing with an implanted medical device, the method comprising:

means for receiving data indicative of an implanted medical device state from the implanted medical device;

means for selecting a subset of commands from a set of commands for performing tasks on the implanted medical device, the subset being selected by the system as a function of the device state communicated from the implanted medical device;

means for displaying the device state data along with the subset of commands;

means for converting an input audio signal from a microphone into a selection code, the input audio signal corresponding to one of the subset of commands;

means for matching the selection code to one of the subset of commands;

means for executing the one of the subset of commands; and

means for receiving data generated by a medical data processing instrument in response to execution of the one of the subset of commands.

20. (Previously presented) A method for interfacing with an implanted medical device, the method comprising:

receiving data indicative of an implanted medical device state from the implanted medical device;

selecting a subset of commands from a set of commands for performing tasks on the implanted medical device, the subset being automatically selected by a processor based on the received device state data;

displaying the device state data along with the subset of commands;
converting an input audio signal from a microphone into a selection code, the input audio signal corresponding to one of the subset of commands;
matching the selection code to one of the subset of commands;
executing the one of the subset of commands; and
receiving data generated by a medical data processing instrument in response to execution of the one of the subset of commands.

21. (Original) The method of claim 20, wherein the step of executing the one of the subset of commands includes the step of validating speech sets received via a memory arrangement coupled to the processor, the memory arrangement having the set of commands stored therein.
22. (Original) The method of claim 20, further comprising the step of producing an audio signal representing the device state with the subset of commands before the step of executing the one of the subset of commands.
23. (Original) The method of claim 20, further comprising the step of suppressing noise from the input audio signal before converting the audio signal into a selection code.
24. (Original) The method of claim 20, further comprising the steps of:
configuring the set of commands via a plurality of voice commands provided by a user of the medical data processing instrument before the step of receiving data indicative of the device state; and
storing the set of commands in a memory arrangement for display.
25. (Original) The method of claim 24, further comprising the step of receiving and validating a user via a user selection code, the user selection code providing access to

differing levels of commands for controlling the processing instrument before the step of receiving the voice selected command.

26. (Previously presented) A method for controlling a medical data processing instrument that interfaces with an implanted medical device, the method comprising:

receiving data from the implanted medical device indicative of the a device state;

utilizing a processor to automatically select a subset of commands from a set of commands based on the received data;

displaying the implanted device state data along with the subset of commands;

receiving a voice command selected from one of the subset of commands;

processing the selected command via a processor and a memory arrangement, the memory arrangement including the set of commands along with a set of control signals, the control signals used for controlling the data processing instrument;

transmitting to the data processing instrument the control signal for executing the selected command for performing a task on the implanted device; and

displaying device state data generated by the data processing instrument in response to executing the selected command.

27. (Original) The method of claim 26, further comprising the step of generating the set of commands to be stored in the memory arrangement via voice commands provided by a user of the data processing arrangement before the step of displaying the device state data.

28. (Original) The method of claim 27, further comprising the step of receiving and authenticating a user selection code for providing access to differing levels of command options before the step of receiving the voice command.

29. (Original) The method of claim 26, further comprising the step of producing a noise-suppressed speech signal corresponding to noise suppression information received after the

voice command is received.

30. (Previously presented) A system for controlling a medical data processing instrument that interfaces with an implanted medical device, the system comprising:

means for receiving device state data from the implanted medical device and automatically selecting a subset of commands from a set of commands based upon the device state data;

means for displaying the implanted device state data along with the subset of commands;

means for receiving a voice command selected from one of the subset of commands;

means for processing the selected command via a processor and a memory arrangement, the memory arrangement including the set of commands along with a set of control signals, the control signals used for controlling the data processing instrument;

means for transmitting to the data processing instrument the control signal for executing the selected command for performing a task on the implanted device; and means for displaying device state data generated by the data processing instrument in response to executing the selected command.

~~JFW~~

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
APPEAL BRIEF TRANSMITTAL

In re Application of: GOEDEKE et al.

For: AUTOMATIC VOICE AND DATA RECOGNITION FOR IMPLANTED MEDICAL DEVICE INSTRUMENT SYSTEMS

Serial No.: 09/731,178

Filed: December 06, 2000



CERTIFICATE UNDER 37 CFR §1.8 I hereby certify that this **APPEAL BRIEF** and the paper(s), as described herein are being deposited with the United States Postal Service, in an envelope addressed to: Mail Stop Appeal Brief – Patents, Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450, on this 23rd day of September, 2005.

Molly McClellan
 Signature
 MOLLY MCCLELLAN
 Printed Name

Mail Stop Appeal Brief – Patents
 Commissioner for Patents
 P.O. Box 1450
 Alexandria, VA 22313-1450

Sir:

We are transmitting herewith the attached:

- Appellant's Appeal Brief (in triplicate)
- Return Postcard
- Please charge a Appeal Brief fee of \$340.00 to Deposit Account No. 13-2546.
- Applicant hereby petitions for a months' extension of time. If an additional extension of time is required, please consider this petition therefor.
- Applicant believes that no extension of time is required. However, if an extension of time is required, please consider this a petition therefor to provide for the possibility that applicant has inadvertently overlooked the need for an extension of time.
- Please charge any additional fees or credits to Deposit Account No. 13-2546 which may have been overlooked on this Missing Parts Transmittal with regard to this filing. A duplicate of this transmittal is enclosed.

Date

9/23/05

DGC
 Daniel G. Chapik, Reg. No. 43,424
 Telephone: (763) 514-3066
 No. 27,581